



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,512	07/29/2003	Kevin John Bateman	14581.0001	5084

7590 05/16/2006
D. Douglas Price
Steptoe & Johnson LLP
1330 Connecticut Avenue, N.W.
Washington, DC 20036

EXAMINER

STOICA, MARIA

ART UNIT	PAPER NUMBER
----------	--------------

3715

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/628,512	Applicant(s) BATEMAN, KEVIN JOHN	
	Examiner Maria Stoica	Art Unit 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/29/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1, 10, and 17 are objected to because of the following informalities: claims 1 and 10 are not in single sentence form as required by MPEP 608.01(m). Regarding claim 10, the examiner suggests the removal of the phrase "In another aspect of the invention is" for recommended format as stated in MPEP 608.01(m). Regarding claim 1, there appears to be a typographical error in the second line "... a plurality of mini-blocks each being identifying a nutrient." The examiner believes this should read "... a plurality of mini-blocks each identifying a nutrient." Regarding claim 17, there appears to be a typographical error and that "of a fat" should read "or a fat." Regarding claim 20, "min" is missing an 'i'. Regarding claim 20, the wording "the mini-blocks are electronically simulated shaped generated by a computer program" is not clear. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-7 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims are single means claims (i.e., a plurality of mini-blocks), where a means recitation does not appear in combination with another recited means, and are therefore subject to undue breadth rejection. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983). The only means of the claim covers every conceivable structure for achieving the stated property, and is held as non-enabling as the specification discloses at most only those procedures known to the inventor.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claims 1 and 10 state "a method and apparatus." The claims must clearly state whether the invention is a method OR an apparatus. Furthermore, method claims should include distinct steps resulting in a tangible result. Claims 1-20 delineate aspects of an apparatus, but no method steps are described.

4. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 recites the limitation "the area for storing mini-blocks" in lines 1-2 of claim 14. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 5-6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlsson (US Patent No. 2,314,387).

Regarding claim 1, Carlsson discloses a dietary planning method and apparatus including a plurality of mini-blocks each identifying a nutrient of a food wherein each mini-block has means to identify a particular food which includes the nutrient signified by the mini-block (col. 3, line 74 – col. 4, line 4) and wherein each mini-block also represents a specific parameter of the food containing the nutrient (col. 4, lines 24-39), and further wherein a plurality of mini-blocks can be combined to form a block to visually display a balanced program of the selected micronutrients (col. 4, lines 13-23).

Regarding claim 2, Carlsson discloses that the specific parameter on each mini-block is the composition of the food (col. 4, lines 30-39).

Regarding claim 5, Carlsson discloses that the description of the food item provided on the back of each block describes the food item in a favorable or unfavorable way (col. 4, lines 40-60) which in turn would indicate to the user whether the item is favorable, not favorable, or a fair choice.

Regarding claim 6, Carlsson discloses that each mini block comprises a physical entity (col. 3, lines 23-25).

Regarding claim 8, Carlsson discloses a template on which the mini-blocks can be displayed (Figure 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-4, 10-12, and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlsson in view of Saari (US Patent No. 5,338,202).

Regarding claim 10, Carlsson discloses a dietary planning method and apparatus including a template having at least one row of spaces, each space in a row being identified with a type of food (Figures 2 and 3), and a plurality of mini-blocks with each mini-block being identified to signify a type of food (col. 3, line 72 – col. 4, line 4), wherein each mini-block has means to identify a particular food in the corresponding type (Figure 3), and wherein each mini-block also contains a parameter of the food (col. 4, lines 9-12), and further wherein the mini-blocks can be located on the template and combined to form a block to visually display the selected food macronutrients (col. 5, lines 49-60). Carlsson does not expressly disclose that the types of food signify an amount of carbohydrate nutrient or a protein nutrient or a fat nutrient of the food,

although the stated purpose of the apparatus and method is to simulate a balanced diet of these nutrients (col. 1, lines 20-26). However, Saari discloses dividing food items based on these nutrient contents (i.e., fats, starches (which are carbohydrates), and meats (which are generally known as a main source of protein) into color coded groups (col. 5, lines 48-56). It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the color coded groups for different nutrients in order to visually indicate to the user how to select components for a balanced diet in those nutrients.

Regarding claims 3, 12, and 15, Carlsson does not expressly disclose that the cards are color coded to indicate carbohydrates, fats, and proteins, although the intended use of the apparatus is to simulate a balanced diet of these nutrients (col. 1, lines 20-26). However, Saari discloses dividing food items based on these nutrient contents (i.e., fats, starches (which are carbohydrates), and meats (which are generally known as a main source of protein) into color coded groups (col. 5, lines 48-56). It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the color coded groups for different nutrients in order to visually indicate to the user how to select components for a balanced diet in those nutrients.

Regarding claims 4 and 16, neither Carlsson nor Saari expressly disclose that the colors assigned to each nutrient group should be: green for carbohydrate, brown for protein, and yellow for fat. However, the selection of specific colors for each group is considered merely a Design Choice, since the specification does not explicitly designate the colors to certain groups for any stated advantage. It would have been obvious to

one of ordinary skill in the art to arbitrarily select any combination of colors to designate the groups in order to assimilate different nutrients to different colors.

Regarding claim 11, Carlsson discloses that the specific parameter on each mini-block is the content of the food (col. 4, lines 30-39).

Regarding claim 17, Carlsson discloses that the colors on the template match the colors on the corresponding mini-blocks (col. 3, line 75 – col. 4, line 2).

Regarding claim 18, Carlsson discloses that the description of the food item provided on the back of each block describes the food item in a favorable or unfavorable way (col. 4, lines 40-60) which in turn would indicate to the user whether the item is favorable, not favorable, or a fair choice.

Regarding claims 13 and 14, Saari teaches that the color coded elements containing the food items thereon, when not used, should be stored in an area with a plurality of spaces which are identified to represent the macro nutrients in the foods (col. 3, lines 28-40).

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carlsson in view of Ekberg (US Patent No. 6,402,144). Carlsson does not expressly disclose that each mini-block includes a substance which can be magnetized. However, Ekberg teaches an educational card game where cards are to be organized on a board in different combinations. These cards are magnetized (Abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the apparatus

of Carlsson as taught by Ekberg in order to allow the cards to stay in place and not fall off, especially if the board is unbalanced.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carlsson in view of Alabaster (US Patent No. 6,585,516). Carlsson does not expressly disclose that each mini block is an electronically simulated unit. However, Alabaster teaches a dietary planning mechanism with components to be used to make up each meal, where the cards are electronically implemented in software (Abstract, Figures 4 & 8). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the system of Carlsson as taught by Alabaster in order to provide an electronic version of the same concept.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carlsson, as modified by Saari, further in view of Ekberg. Neither Carlsson, as modified by Saari, does not expressly disclose that each mini-block includes a substance which can be magnetized. However, Ekberg teaches an educational card game where cards are to be organized on a board in different combinations. These cards are magnetized (Abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the apparatus of Carlsson, as modified by Saari, as taught by Ekberg in order to allow the cards to stay in place and not fall off, especially if the board is unbalanced.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carlsson, as modified by Saari, further in view of Alabaster. Carlsson, as modified by Saari, does not expressly disclose that each mini block is an electronically simulated unit. However, Alabaster teaches a dietary planning mechanism with components to be used to make up each meal, where the cards are electronically implemented in software (Abstract, Figures 4 & 8). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the system of Carlsson, as modified by Saari, as taught by Alabaster in order to provide an electronic version of the same concept.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Robertson et al. (US Patent No. 5,044,958) relates to a diet organizer using different cards that describe nutrients in different foods.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria Stoica whose telephone number is (571) 272-5564. The examiner can normally be reached on M-F: 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3715

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MS

W

Kathleen Mosser
KATHLEEN MOSSER
PRIMARY EXAMINER